PATENT
Customer No. 22,852
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	
Gérard LANG et al.	Group Art Unit: 1751
Application No.: 09/424,116	Examiner: M. Einsmann
Filed: January 6, 2000	
For: OXIDATION DYEING COMPOSITION FOR KERATINOUS FIBRES CONTAINING A 3-AMINOPYRIDINE AZO DERIVATIVE AND DYEING METHOD USING SAID COMPOSITION	

Mail Stop Appeal Brief--Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 1.193

Pursuant to 37 C.F.R. § 1.193, Appellants submit this Reply Brief in triplicate to the Board of Patent Appeals and Interferences in response to the January 28, 2004, Examiner's Answer, in the above-identified application.

If any fees are required, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

I. Response to Examiner's Answer

A. Claims 26 – 60 are Patentable Under 35 U.S.C. § 103(a) Over U.S. Patent No. 5,919,273 to Rondeau *et al.* (Rondeau '273).

The Examiner's obviousness contention is that "[i]t would have been obvious ... to formulate a composition ... [according to the presently claimed invention] because Rondeau ['273] teaches compositions, processes and kits which includes a position[al] isomer of applicant's claimed dye." (Office Action of February 12, 2003, pg. 9, ln. 13-16.) The Examiner specifically bases the rejection on Rondeau '273 dye II-30, which the Examiner characterizes as a positional isomer of a cationic direct dyes according to the presently claimed invention. (Office Action of July 31, 2002, pg. 8, ln. 3-7.) As explained below, the arguments contained in the Examiner's Answer in support of this rejection are flawed because (1) a prima facie obviousness is asserted in the absence of any motivation to make the claimed composition, (2) there is not, even arguably, a motivation or reasonable expectation of success for forming a specific isomer outside the scope of Rondeau's generic dye formula (II), as proposed by the Examiner, and (3) the rejection is wrongly premised on an obvious to try standard.

1. THE EXAMINER'S ANSWER IS FLAWED FOR ARGUING PRIMA FACIE OBVIOUSNESS IN ABSENCE OF ANY MOTIVATION TO MAKE THE CLAIMED COMPOSITION

In order to establish a prima facie case of obviousness based on similar chemical structure, the Examiner must show that "the prior art gives reason or motivation to make the claimed compositions ...." *In re Dillon*, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990). In conflict with this *en banc* precedent, the Examiner has not shown (and the cited art does not contain) any evidence of a motivation for the proposed modification of Rondeau's dye II-30. Instead, the Examiner has taken the legally erroneous position that "the use

of an isomeric cationic hair dye to replace a cationic hair dye in a hair dyeing composition is prima face obvious." (Examiner's Answer at 4.)[1]

In the Examiner's Answer the Examiner does attempt to assert that there would have been motivation to start with Rondeau's dye II-30 because

> [t]he real fact is that dye II-30 is listed as a preferred dye. See col. 8, lines 43 - 48. It is even claimed specifically as part of the composition claimed by Rondeau in claim 19 ....

(Examiner's Answer at 5.) But, this is not the "real fact." Rondeau does not identify dye II-30 as a preferred dye, and does not positively distinguish it from the over 40 other exemplified compounds.

After describing the genus of formula (II) at column 2, line 45 to column 5, line 26, what Rondeau states at column 8, lines 43 - 48 is that:

> Among the cationic direct dyes of formula (II) which can be used in the ready-to-use dye compositions in accordance with the invention, mention may be made more particularly of the compounds corresponding to structures (II1) to (II43) below....

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[1] In the Examiner's Answer, the Examiner seems to suggest that Appellants have misrepresented the standards for structural obviousness, which state that isomers are not necessarily prima facie obvious. Specifically, according to the Examiner, Appellants' citation of the M.P.E.P. as stating that "[i]somers ... are not necessarily considered equivalent by chemists skilled in the art and therefore are not necessarily suggestive of each other," M.P.E.P § 2144.09, citing *Ex parte Mowry*, 91 USPQ 219 (Bd. App. 1950), is somehow a quotation of *Mowry* that is out of context. (Examiner's Answer at 5.) This is not the case. The quotation is to the M.P.E.P., not *Mowry*, so *Mowry* has not been cited out of context by Appellants. Further, the Examiner's attempt to distinguish *Mowry* is unsound. The Examiner's argument that, unlike the isomeric compounds in *Mowry*, "[t]he structure of the isomers in the instant case have the same empirical formula [as each other] as well as a very close structural formula" (Examiner's Answer at 5) is flawed because, by definition, all isomers have the same empirical formula and most may have close structural formula. Contrary to the Examiner's contention, there is no distinction with *Mowry* on this point.

Thus, rather than characterizing the listed compounds a preferred, Rondeau is only providing a listing of exemplarily compounds within the scope of the genus of formula (II) "which can be used." That is, the listed compounds are examples of particular compounds within the broad genus. Nowhere is this entire list of over 40 compounds is dye II-30 itself identified as a preferred compound over the other listed compounds.

The Examiner's attempt to equate the listing of exemplary compounds with a list of preferred compounds mischaracterizes the above-quoted statement from Rondeau and is in direct conflict with the express disclosure of document as a whole. In fact, Rondeau separately identifies preferred compounds. Specifically, from among the exemplary compounds II-1 to II-43, compounds II-1, II-2, II-14, and II-31 "are more particularly preferred." (Rondeau, col. 14, ln. 27-29.) Thus, the listing of 43 compounds is not a listing of preferred compounds. Only dyes II-1, II-2, II-14, and II-31 are identified as preferred over the other 38 compounds. Dye II-30 is not a preferred compound among this listing of 43 compounds.

The Examiner's reliance on dye II-30, therefore, cannot be because it was identified as a preferred compound. Rather, the Examiner's focus on dye II-30 can only be attributed to the fact that it is an isomer of a dye according to the presently claimed invention. Although a reference may be relied upon for all it fairly teaches, including non-preferred embodiments, it is reversible legal error to fail to consider the parts of the document that teach away from Appellants' claimed invention, including, in this case, the expressly preferred compounds according to Rondeau. *E.g. In re Fine*, 5 USPQ2d

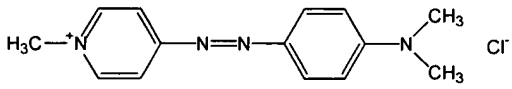
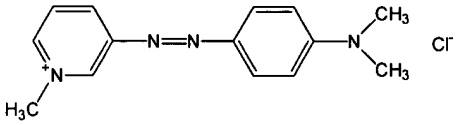
1596, 1600 (Fed. Cir. 1988); *W.L. Gore & Assoc. v. Guardlock*, 220 USPQ 303, 311 (Fed. Cir. 1983).

In this regard, the Examiner is closely following the path foreclosed by the Federal Circuit in *Yamanouchi Pharm. Co. v. Danburry Pharamacal Inc.,* 56 USPQ2d 1641 (Fed. Cir. 2000). There, the patent challenger had identified "example 44" in the prior art as a lead compound close in structure to the patentee's claimed compound, and argued that modification of example 44 would have been obvious. *Id.* at 1644. The Federal Circuit cut this argument short because no motivation had been shown for selecting example 44 in the first place. *Id.* at 1645. Just as the asserted motivation of the activity of example 44 did not hold water as a basis to preferentially start with example 44 as a lead compound, because "[i]f activity alone was the sole motivator, other more active compounds would have been the obvious choice, not example 44," *id.*, if a statement of preference were the motivator for choosing a compound from Rondeau,[2] dyes II-1, II-2, II-14 and II-31 expressly identified in Rondeau as preferred would have been the obvious choice, not dye II-30.

2. THE EXAMINER'S ANSWER DOES NOT EVEN POSIT A MOTIVATION OR ARGUE A REASONABLE EXPECTATION OF SUCCESS FOR FORMING A SPECIFIC ISOMER OUTSIDE THE SCOPE OF RONDEAU'S GENERIC DYE FORMULA (II)

In addition to the Examiner's original focus on dye II-30 being hindsight driven, the Examiner's proposed modification of dye II-30 is also unsupported by any motivation of record and evidently also based purely on hindsight. In particular, not even in the

[2] In this regard, the Examiner has not even posited any other alleged motivation for selecting dye II-30 for further modification.

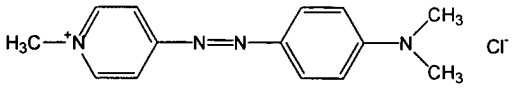
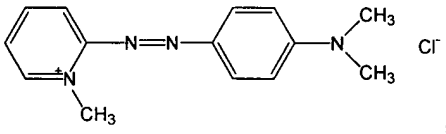
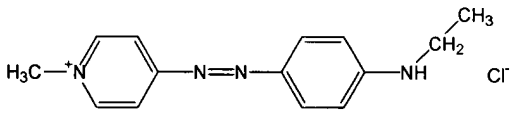
Examiner's Answer does the Examiner identify any sound basis for converting Rondeau's dye II-30,  , which has a 4-piperidine group, into  , which is a 3-piperidine compound within the scope of formula (I) according to Appellants' claim 26. As explained below, the absence of any motivation for the proposed modification of dye II-30 is particularly noteworthy given (1) the thousands of other possible isomers, and (2) that the proposed modification yields a dye outside the scope of Rondeau's general formula (II).

As explained in the Appeal Brief at footnote 2, dye II-30 has more than 10,000 isomers, and there is no motivation for selecting the undisclosed 3-piperidine isomer. The Examiner seems to suggest that the calculation of the more than 10,000 isomers is somehow flawed because "[i]t is not clear why appellant is moving all of the groups around in coming to his conclusion." (Examiner's Answer at 6.) However, this is not the correct question to be asking.[3]

The question of why certain groups are being moved around is best applied to the Examiner's proposed modification, since the Examiner has the burden of showing evidence of a motivation to make the proposed modification. In particular, except because it yields a compound within the scope of the presently claimed invention, it is not clear why the Examiner is moving the piperidine group around in coming to her

[3] Moreover, the reason the groups of dye II-30 are moved around is to estimate the number of isomers because compounds having the same empirical formula but different structures is exactly the definition of structural isomers, and the "moving... around" is exactly what the Examiner has proposed with respect to modifying dye II-30.

conclusion. For example, there is no evidence in Rondeau that modifying dye II-30 from a 4-piperidine to a 3-piperidine would yield an improved or even an equally useful compound, nor would any be present in Rondeau since the 3-piperidine is outside the scope of Rondeau's disclosure.

Except for hindsight directing the Examiner to a compound within the scope of Appellants' claimed invention, if dye II-30  were to be selected, and if dye II-30 were to be subject to further modification, it could have been converted to its 2-piperidine isomer  , which, unlike the Examiner's proposed modification, is still within the scope of Rondeau's formula (II). (Rondeau, col. 4, ln. 35, A_{13}.) Likewise, but for hindsight, dye II-30 could also have been converted to its ethyl amine isomer  which, again, unlike the Examiner's proposed modification, is still within the scope of Rondeau's formula (II) (Rondeau, col. 2, ln. 41-67, R_4=H, R_5=CH_2CH_3). Or, equally, dye II-30 or any of the other 42 disclosed dyes could have been modified to other isomers within the scope of Rondeau's formula (II). Thus, to the extent that there would have been any motivation according to Rondeau to modify one of its dyes, rationally, that motivation would be directed to a compound <u>within</u> the scope of Rondeau's general formula (II), which is part of the disclosed invention. (*E.g.*, col. 2, ln. 41 – col. 5, ln. 25.) Yet, unsupported by any evidence or even sound reasoning, the Examiner's proposed modification results in a dye <u>outside</u> the scope of Rondeau's general formula (II).

Even assuming that no motivation is needed to modify dye II-30 to one of its isomers where there is a expectation that structurally related the compounds will have similar properties, that expectation does not apply here. As emphasized above, 3-piperidine compounds are not even within the scope of the generic formula (II) according to Rondeau, and cannot be expected *a priori* to have the properties attributed to that genus. (Rondeau, col. 2, ln. 41 to col. 5, ln. 25, wherein group A includes 4-piperidines (A_4) and 2-piperidines (A_{13}), but does not include 3-piperidines.) Further, rather than having similar properties, even the Examiner concedes that "[o]ne would expect related dyes to have unique properties, and to produce different colors." (Examiner's Answer at 7.) Thus, there is no basis for the Examiner to assert that dyes are prima facie obvious from one another based solely on an isomeric relationship. The fact that the proposed modification yields a compound outside of Rondeau's general formula makes any such presumption especially untenable.

3. THE EXAMINER'S ANSWER IS WRONGLY PREMISED ON AN OBVIOUS TO TRY STANDARD

The Examiner has effectively admitted that rather than being obvious, the proposed modification of Rondeau is at best obvious to try, which is distinct from obviousness under section 103. *In re O'Farrell*, 7 USPQ2d 1673 (Fed. Cir. 1988). In particular, the Examiner stated that "there is a demand in the hair dyeing arts to match a myriad of different colors, [therefore] the dye chemist is always looking for new dyes related to those previously known." (Examiner's Answer at 7.) That is, rather than being an obvious variant, the reason for considering isomers is to look for new colors, which is the epitome of an "obvious to try" stituation. As explained by the Federal

Circuit:

> An "obvious-to-try" situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursed.

In re Eli Lilly & Co., 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Thus, the rejection is further improper because the Examiner has confused a potential research project, where "the dye chemist is always looking for new dyes related to those previously known," with what would have been obvious from the art itself.

Accordingly, Appellants respectfully maintain that the rejection is in error and should be reversed.

B. Claims 26-60 Are Patentable Under The Judicially Created Doctrine Of Obviousness-Type Double Patenting Over U.S. Patent No. 5,919,273.

The Examiner's Answer lacks any substantive arguments with respect to this obviousness-type double patenting rejection, beyond those applied to the rejection under 35 U.S.C. § 103, discussed in section A, above. Appellants likewise stand on the remarks above and those of record, and respectfully maintain that the rejection is in error and should be reversed.

C. Claims 26-60 are Patentable Under 35 U.S.C. § 103(a) Over U.S. Patent No. 4,025,301 (Lang) in View of U.S. Patent No. 4,588,410 (Konrad).

In the Examiner's Answer, the Examiner argues that "[a]dequate motivation to [replace m-aminophenol coupler in the composition and process of Lang with the substituted m-aminophenol coupler from Konrad] is supplied by Konrad ... who teaches

the substituted m-aminophenol as an improvement over m-aminophenol."[4] (Examiner's Answer at 7.) In essence, the Examiner's position is that she can rely on Konrad as motivation to replace m-aminophenol in any and all compositions. Yet, the disclosure of Konrad is not so broad and the variability in the art not so narrow.

While the Examiner admits that "each dye component alters the overall color of the resultant hair" (Examiner's Answer at 10), the Examiner continues to err by extrapolating limited criticisms and limited advantages of Konrad's substituted m-aminophenol to any and all compositions containing m-aminophenol. This position conflicts with the express disclosure of Konrad, where certain m-aminophenol compositions are even identified as preferred, as well as other evidence of record. Thus, as explained further below, because the components of the relevant chemical compositions can and do interact, it is legally and technically improper for the Examiner to extrapolate Konrad's criticisms of m-aminophenol in combination with certain specific

[4] The Examiner attempts to respond to Appellants position that Konrad does not provide motivation for use of their substituted m-aminophenol in a composition according to Lang by arguing that "one cannot show nonobviousness by attaching references individually where the rejections are based on combinations of references." (Examiner's Answer at 8.) While the Examiner has correctly paraphrased a statement from *In re Keller*, 208 USPQ 871 (CCPA 1981), it is illogical for the Examiner to expressly rely on Konrad as the source of the motivation to combine the references while at the same time arguing that the alleged motivation attributed to Konrad cannot be questioned. Accordingly, since this improper argumentation is the key response to Appellants' position, the Examiner has not and cannot refute the fact that, to the extent Konrad provides any motivation for using their substituted m-aminophenol in place of m-aminophenol, the motivation is limited to specific types of compositions distinct from those of Lang. Moreover, even when the combination of Lang in view of Konrad is considered, the Examiner has not cited, and the references do not contain, any other motivation for the proposed combination. For at least these reasons, Appellants respectfully maintain that the Examiner has not established, and the references do not support, a prima facie case of obviousness.

oxidation bases to compositions according to Lang that have different oxidation bases as well as direct dyes.

Moreover, by relying on a flawed motivation for combining the disclosures of Lang and Konrad, the Examiner has contravened the invention "as a whole" requirement, recently reemphasized by the Federal Circuit. In particular, in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004), it was held that:

> The "as a whole" instruction in title 35 [section 103] prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.

Thus, for at least the reasons that the Examiner's obviousness assessment is based on reconstructing the invention from component parts (A + B + C) and fails to consider the invention as a whole, the rejection is in error and should be reversed.[5]

[5] The court in *Ruiz* did find that the combination in question would have been obvious, relying on a motivation to combine the prior art references based in the nature of the problem to be solved, noting that "[t]his form of motivation to combine evidence [being] particularly relevant with simpler mechanical technologies." *Id.* at 1266-67. In this regard, *Ruiz* is distinct from the present case, since the Examiner has not alleged and the record does not support an analogous motivation based on the nature of the problem to be solved, especially given the absence of any problem attributed to Lang example q. (See Section 1, below.)

1. THE EXAMINER'S ANSWER IS BASED ON THE INACCURATE ASSUMPTION THAT ALL M-AMINOPHENOL COMPOSITIONS ARE DEFICIENT

The Examiner's position is based on the premise that Konrad teaches that any and all compositions containing the coupler m-aminophenol are deficient and can be improved by replacing that coupler with Konrad's substituted m-aminophenol. In the Examiner's Answer, for example, the Examine asserts that

> the disadvantages of m-aminophenol as [a] coupler are taught by Konrad who teaches that [their] 2-hydroxy-4-aminobenzenes were developed to replace m-aminophenol because of known disadvantages of m-aminophenol in combination with resorcinol, p-phenylenediamines, 2,5 diaminotolune and p-aminophenol.

(Examiner's Answer at 9.) This characterization of Konrad is not accurate.[6] The premise that Konrad's substituted couplers were developed to replace m-aminophenol in any and all compositions is also false, and is contradicted by the express disclosure of Konrad.

In fact, there are three and only three situations where Konrad criticizes the use of m-aminophenol or arguably suggests that their substituted coupler may have advantages. These are:

> (1) M-aminophenol with p-aminophenol: According to Konrad the problem of weak color tone resulting from the coupler/base pair m-aminophenol and p-aminophenol is overcome by the use of their substituted couplers together with the p-aminophenol to yield intensive fashionable copper tone. (Konrad, col., 3, ln. 1-25.)

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[6] Among other things, the Examiner is not correct that Konrad's couplers are suggested to overcome disadvantages of m-aminophenol when used with resorcinol. As explained further below, Konrad expressly states that the combination of m-aminophenol and resorcinol are preferred, and yield natural, warm color tones. (Konrad, col. 2, ln. 24-31.)

> (2) M-aminophenol with p-diamines: According to Konrad, the absence of red tones when m-aminophenol is used with p-diamines like 2,5-diaminotoluene or 2,5 diaminobenzene alcohol is solved by the use of their substituted coupler with p-diamines. (Konrad, col. 2, ln. 32-38; col. 3, ln. 6-12.)
>
> (3) Substituted m-aminophenol with 2,5-diaminobenzene and pyrimidine: According to Konrad, their substituted couplers can be used in combination with the developers 2,5-diaminobenzene and pyrimidine to create interesting violet tones. (Konrad, col. 3, ln. 21-25.)

Beyond these three limited situations, Konrad does not provide any other criticisms of m-aminophenol or alleged advantages of their substituted couplers. In fact, Konrad expressly states that the use of m-aminophenol is preferred in certain circumstances.

> Preferably, resorcin and m-aminophenol [together] as a coupler in conjunction with p-phenyldiamines or 2,5-diaminotoluene are used as a developer for generating natural color tones. The yellow coloring caused by resorcin is covered by adding m-aminophenol and in this manner the color tone is adjusted as a whole to a warmer color tone.

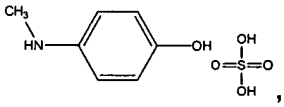
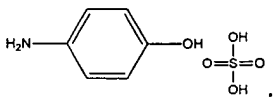
(Konrad, col. 2, ln. 24-31.) Thus, natural color tones, having no net deficiencies, are obtained with resorcin and m-aminophenol together as couplers in conjunction with p-phenyldiamines or 2,5-diaminotoluene oxidation bases. For this composition, for example, there is no problem to be solved by use of Konrad's substituted couplers.

The Lang composition relied upon by the Examiner, Example q, in fact has resorcin and m-aminophenol (as well as metadiamincanisole sulfate) as couplers in conjunction with a 2,5-diaminotoluene oxidation base (paratoluylene diamine) and also para aminophenol and N-methyl para aminophenol sulfate oxidation bases. Moreover, Lang example q yields the apparently favorable dyeing result referred to as "a particularly luminous light coppery golden blond coloration." (Lang, col. 22, ln. 41-43.)

Thus, the Lang composition considered as a whole already contains oxidation bases and couplers said by Konrad to be preferred, and already yields a desirable coloration. For this composition, there is no problem to be solved. There is also no teaching or suggestion in Konrad or Lang that Konrad's substituted coupler would be desirable for use in a composition such as this one. Given these facts, the Examiner's argument that one would have been motivated to replace the m-aminophenol in Lang is clearly not supported by and is in conflict with the express disclosures of Konrad and Lang.

2. THE EXAMINER'S ANSWER MISCHARACTERIZES LANG EXAMPLE Q

In the Examiner's Answer, the Examiner argues that Lang Example q contains "p-aminophenol sulfate" as an oxidation base, and states that this oxidation base is listed in Konrad as showing improvements when combined with Konrad's substituted coupler. (Examiner's Answer at 9-10.) The Examiner relies on this characterization to argue that Konrad suggests the use of their substituted coupler in a composition such as Lang Example q. The Examiner is wrong.

First and foremost, Lang Example q contains N-methyl-para aminophenol sulfate,  , which is distinct from para aminophenol sulfate,  .

Second, Konrad does not teach or suggest the use of their substituted couplers with N-methyl-para aminophenol, either as a free base or salt such as the sulfate. In fact, Konrad makes no mention of N-methyl-para aminophenol.

Third, as discussed further below, since dyeing properties may result from a complex interaction of all the dyeing components, even if Lang example q did contain para aminophenol sulfate, it would be technically and legally improper for the Examiner

to extrapolate effects and comments in Konrad with respect to individual components to other distinct complex, multi-component systems that are neither disclosed nor discussed with reference to the substituted coupler.

The Examiner's position that Konrad suggests the use of their substituted couplers with all the bases, much less the specific combination of bases, contained in Lang example q is, therefore, unsupported and unsupportable.

3. THE EXAMINER WRONGLY IGNORES INTERACTION AMONG HAIR DYE COMPONENTS

In the Examiner's Answer, the Examiner acknowledges that "each dye component alters the overall color of the resultant hair." (Examiner's Answer at 10.) Although the Examiner attempts to distance the predictability necessary for the present obviousness rejection[7] from her previous inconsistent statement that "[i]t is unclear how these additional [oxidation bases and couplers] effect the overall results [of the dyeing composition]" (*id.*), the fact remains that dyeing components can interact unpredictability to alter the resultant dyeing properties. The Examiner's Answer does not dispute this point, as set forth in more detail in pages 26-30 of the Appeal Brief.

Thus, since it is undisputed that dye components can interact, a composition **A + B + C** can be fundamentally different from a composition **A + B**, and the effects of modifications to **A + B** cannot be relied upon as predictive of the effects of modifying a composition **A + B + C**. As shown in the Appeal Brief, the effects of changing from m-aminophenol to a substituted coupler clearly depend on the direct dye. (Appeal Brief, pg. 28, Table 2.) The presence of a direct dye simply cannot be ignored, as implied by

[7] "[A]t least some degree of predictability is required." (M.P.E.P. § 2143.02.)

the Examiner (Examiner's Answer at 9). It is due to this undisputed interaction of dye components that any criticisms of m-aminophenol or advantages of a substituted m-aminophenol alleged by Konrad with certain oxidation bases cannot be properly extrapolated to the more complex, multi-component compositions of Lang that contain oxidation bases such as N-methyl-para aminophenol and direct dyes not contemplated by Konrad.

4. THE EXAMINER'S ANSWER CONTINUES TO IMPROPERLY RELY ON *KERKHOVEN* AS A SHORT CUT TO ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS WITHOUT FIRST ESTABLISHING THE ELEMENTS OF A PRIMA FACIE CASE

In response to discussion at page 31-34 of the Appeal Brief addressing some of the many reasons why *In re Kerkhoven,* 205 USPQ 1069 (CCPA 1980), is not applicable to the present facts and why other cases, such as *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), and *In re Geiger,* 2 USPQ2d 1276 (Fed. Cir. 1987), are more applicable to the present situation, the Examiner's Answer lacks any further explanation of why it is proper to allege prima facie obviousness absent, *inter alia*, a motivation to combine.[8] (*See, e.g.,* Examiner's Answer at 11.)

The Examiner does make the factual assertion that "[i]t is well established that the cationic azo dyes does not react with the oxidation bases or couplers." (Examiner's Answer at 11.) But this allegedly "well established" concept is based on only "unknown

[8] The Examiner does cite *Ex part Lang,* Appeal No. 2003-0465, but this is an unpublished, non-binding decision, and it does not address all the same issues as the present case.

authority," and therefore cannot be relied upon to support the present rejection. *In re Lee,* 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).[9]

Accordingly, Appellants respectfully maintain that the presently claimed invention is not prima facie obvious over Lang in view of Konrad.

D. Claims 37-39 are Patentable Under 35 U.S.C. § 103(a) Over Lang in view of Konrad in further view of U.S. Patent No. 6,001,135 (Rondeau '135).[10]

The Appeal Brief relied upon *United States v. Adams*, 383 U.S. 39 (1966), *In re Ruff*, 118 USPQ 340 (CCPA 1958), *In re Jezl*, 158 USPQ 98 (CCPA 1968), and *Ex parte Maubru*, Appeal No. 2003-0617 (BdPatApp&Int 2003) to demonstrate that under the relevant standards, mere common listing does not establish equivalence and alleged equivalence cannot be relied upon as motivation to combine functional components. (Appeal Brief at 35-37.) In response, the Examiner only addressed

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[9] The Examiner's attempt to rely on an unsupported alleged fact is also expressly counter to examination policy, which is that "[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation of some reference work recognized as standard in the pertinent art." S.G. Kunin, U.S. PTO Dep. Comm. Patent Examination Policy, "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice," (Feb. 21, 2002) (emphasis in original, footnotes omitted).

[10] The Examiner Lang and Konrad as applied to claim 26 (Section C, above) and relies on Rondeau '135 "for teaching the equivalence of the double base as claimed in claim 37 to the oxidation bases used in Lang when used in compositions containing cationic direct dyes." (Office Action of July 31, 2002, pg. 7, ln. 12-14.) In support of this contention, the Examiner cites (*id.*) a three-column long list of oxidation bases that is identified as "[t]he oxidation base(s) which can be used in the ready-to-use dye compositions in accordance with the invention ...." (Rondeau '135, col. 7, ln. 65-67.)

Maubru, and did not dispute the relevant principles of *Adams*, *Ruff*, or *Jezl*. Further, the Examiner's attempt to distinguish *Maubru* is flawed.

Specifically, the Examiner's attempt in the Examiner's Answer to distinguish *Maubru* is not persuasive. What the Board said in that case was that "the fact that [a reference] may establish the equivalence of the solvents for one purpose is not sufficient to establish their equivalency for all purposes." *Maubru* at 7-8 (Appeal Brief Appendix II). Contrary to what may be implied in the Examiner's Answer, the Board's Decision did not suggest that equivalency is absent only where commonly listed components are used for other than the purpose expressed with respect to that list. As Appellants understand the decision in *Maubru*, the Board merely recognized the technical reality that while a solvent may be useful in one set of conditions (*e.x.,* solutes and co-solvents), neither that solvent nor other solvents equivalent in those conditions are necessarily useful, even as solvents, in another set of conditions (*e.x.,* different solutes and co-solvents).

Likewise, it is consistent with the finding of no equivalency in *Maubru* that just because two oxidation bases "can be used in the ready-to-use dye compositions in accordance with the invention [of Rondeau '135]," this does not make the dyes equivalent for use in a specific composition according to Lang. This is also consistent with the holding of *Jezl* that "mere inclusion of several compounds in a list of compounds... does not necessarily establish that each of those compounds is 'equivalent' to the others for all purposes, even assuming... that 'equivalency' is a proper criterion for establishing obviousness under 35 U.S.C. § 103." 158 USPQ at 100 (citations omitted).

For these reasons, and based on the holdings of *Adams* and *Ruff* that are not disputed by the Examiner, Appellants respectfully maintain that the present rejection is in error and should be reversed.

II. Conclusion

Each rejection should be reversed and withdrawn.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: March 26, 2004

By: _____
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